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Eric C Anderson

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EXAMINER

DASTOURI, MEHRDAD

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 07/13/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/526,252

Applicant(s)

GOHRING, WOLFGANG

Examiner

Mehrdad Dastouri

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendment filed April 16, 2004, has been entered and made of record.
2. Applicants' arguments have been fully considered but they are not persuasive. Applicants' argue in essence that Haneda (Prior art of record) does not disclose a method or system in which information that changes defaults for the album is received from the user separately from the user setting the default.

The Examiner disagrees and indicates that according to the teachings of the prior art of record (Haneda), user interactively access the user's disk utilizing the playback machine and communication unit 19 that enables changing the defaults in subsequent efforts in separate communication from the initial settings of the default.

The user's disk illustrated in Figure 30 is the digital album provided to the user that allows the user to manipulate the defaults by changing the Tags IX1 and IX2 or hypertexts 1-26.). Utilizing the playback machine and communication unit 19, user is capable of changing the defaults (e.g., number of prints) in subsequent communications separate from the initial communication with the Lab in which the original settings of the defaults are provided (Column 17, Lines 43-67; Column 18, Lines 32-67, Column 19, Lines 1-6; Figures 18 and 23, number of copies or size of the photographs; Column 22, Lines 49-56; Column 23, Lines 19-23; Figure 30; Column 28, Lines 5-45).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 5-20 and 24-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda (U.S. 6,459,511).

Regarding Claim 1, Haneda discloses a method for providing a user with an album including a plurality of pages, the method comprising the steps of:

(a) allowing a user to purchase at least a portion of the album, the portion of the album including a portion of the plurality of pages (Figures 19-23; Column 22, Lines 63-67, Column 23, Lines 1-29);

(b) allowing the user to set a plurality of defaults for the plurality of pages, at least one default of the plurality of defaults capable of being altered using information provided by the user (Figures 18 and 23, number of copies or size of the photographs; Column 22, Lines 49-56; Column 23, Lines 19-23; Figure 30; Column 28, Lines 5-45);

(c) receiving from the user the information, if any, and a plurality of images captured using a digital imaging device, wherein the information receiving device further includes the steps of:

(c1) receiving a tag stored in at least one image file for a first portion of the plurality of images, the tag for altering at least one default of the plurality of defaults for the first portion of the plurality of images (Figures 10 and 11; Column 19, Lines 26-67, Column 20, Lines 1-19; Figure 24, Tags IX1 and IX2, Figures 25-27 and 30; Column 23, Lines 32-67, Column 24, Column 25, Lines 1-28; Column 28, Lines 5-67, Column 29 through Column 32, Line 33. The user's disk illustrated in Figure 30 is the digital album provided to the user that allows the user to manipulate the defaults by changing the Tags IX1 and IX2 or hypertexts 1-26.); wherein the tag received in the image file in step (c1) is received in a separate communication from the user setting the plurality of defaults in step (b) (Column 17, Lines 43-67; Column 18, Lines 32-67, Column 19, Lines 1-6; Figures 18 and 23, number of copies or size of the photographs; Column 22, Lines 49-56; Column 23, Lines 19-23; Figure 30; Column 28, Lines 5-45).

(d) altering the at least one default if the user has provided the information (Figure 11; Column 20, Lines 37-59; Figure 25, Column 24, Lines 19-39);

(e) providing the portion of the plurality of pages using the plurality of defaults (Figures 30, 31, 34-38); and

(f) allowing the user access to the at least the portion of the album (Figure 2; Column 18, Column 19, Lines 1-16).

Regarding Claim 5, Haneda further discloses the method of Claim 1 wherein the album is a printed photo album and wherein the access allowing step (f) further includes the step of:

(fl) providing the portion of the plurality of pages to the user (Figures 19-23; Column 22, Lines 63-67, Column 23, Lines 1-31).

Regarding Claim 6, Haneda further discloses the method of Claim 5 wherein a second portion of the plurality of images include sound and wherein the step of providing the portion of the plurality of pages further includes the steps of:

(e1) printing the portion of the plurality of pages (Figures 18 and 23; Column 22, Lines 49-62); and

(e2) providing a mechanism for a user to hear the sound for the second portion of the plurality of images (Figure 33; Column 34, Lines 30-44; Figures 34, 35, 48, 51, 53, 55; Column 42, Lines 4-11; Column 43, Lines 38-51; Column 46, Lines 1-25).

Regarding Claim 7, arguments analogous to those presented for Claims 1 and 6 are applicable to Claim 7. Haneda further discloses the mechanism includes a printed stripe playable by a scanning device and wherein the providing step (e 1) further includes the step of:

(e1i) providing the scanning device to the user (Figure 27, Film Scanner 12A).

Regarding Claim 8, Haneda further discloses the method of Claim 6 wherein the mechanism providing step (e2) further includes the step of:

(e2i) providing a user playable device within a second portion of the portion of the plurality of pages, the second portion of the plurality of pages including the portion of the plurality of images including sound (Figures 34-37; Column 35, Lines 56-67, Column 36, Column 37, Lines 1-19).

Regarding Claim 9, Haneda further discloses the method of Claim 1 wherein each image of a portion of the plurality of images includes a caption and wherein the providing step (e) further includes the step of:

(e1) providing the caption for each of the portion of the plurality of images (Figures 43-46; Column 40, Lines 46-67, Column 41, Lines 1-15).

Regarding Claim 10, Haneda further discloses the method of Claim 9 wherein the caption for each of the portion of the plurality of images is a user-recorded caption and wherein caption providing step (e1) further includes the step of:

(e1i) reading the user-recorded caption for each of the portion of the plurality of images (Figures 43-46; Column 40, Lines 46-67, Column 41, Lines 1-15);

(e1ii) converting the user-recorded caption for each of the portion of the plurality of images to a text caption (Figures 43-46; Column 40, Lines 46-67, Column 41, Lines 1-15); and

(e1iii) printing the text caption for each of the portion of the plurality of images (Figures 47-50; Column 44, Lines 13-47).

Regarding Claim 11, Haneda further discloses the method of Claim 1 wherein the at least one default includes a page layout (Figures 31, 45, 46 and 49).

Regarding Claim 12, Haneda further discloses the method of Claim 1 wherein the at least one default includes a page style (Figures 31, 45, 46 and 49).

Regarding Claim 13, Haneda further discloses the method of Claim 1 wherein each image of a portion of the plurality of images includes a category and wherein the at least one default includes a photo album organization based on the category of each

image of the portion of the plurality of image (Figures 31, 34-38; Column 35, Lines 43-67, Column 36, Lines 1-29).

Regarding Claim 14, Haneda further discloses the method of Claim 1 wherein the at least one default includes selecting image analysis for the plurality of images (Figure 38, Compression Scheme and Image Resolution).

Regarding Claim 15, Haneda further discloses the method of Claim 1 wherein the purchase step (a) further includes the step of:

(a1) allowing the user to purchase the at least the plurality of pages from a remote location (Column 31, Lines 24-39; Column 32, Lines 28-33).

Regarding Claim 16, Haneda further discloses the method of Claim 1 wherein the at least one default selecting step (b) further includes the step of:

(b2) allowing the user to select the at least one default from a remote location (Column 22, Lines 49-56; Column 23, Lines 19-23; Figure 30; Column 28, Lines 5-45).

Regarding Claim 17, Haneda further discloses the method of Claim 1 wherein a portion of the plurality of images include sound and wherein the step of providing the portion of the plurality of pages (e) further includes the steps of:

(e1) archiving the portion of the plurality of pages (Figures 43-50); and

(e2) providing a mechanism for a user to hear the sound for the portion of the plurality of images (Abstract; Figure 51; Column 9, Lines 1-6; Column 44, Lines 40-60).

With regards to Claim 18, arguments analogous to those presented for Claim 9 are applicable to Claim 18.



With regards to Claim 19, arguments analogous to those presented for Claim 10 are applicable to Claim 19.

With regards to Claims 20 and 38, arguments analogous to those presented for Claim 1 are applicable to Claims 20 and 38.

With regards to Claims 24 and 25, arguments analogous to those presented for Claim 6 are applicable to Claims 24 and 25.

With regards to Claim 26, arguments analogous to those presented for Claim 7 are applicable to Claim 26.

With regards to Claim 27, arguments analogous to those presented for Claim 9 are applicable to Claim 27.

With regards to Claim 28, arguments analogous to those presented for Claim 10 are applicable to Claim 28.

With regards to Claim 29, arguments analogous to those presented for Claim 11 are applicable to Claim 29.

With regards to Claim 30, arguments analogous to those presented for Claim 12 are applicable to Claim 30.

With regards to Claim 31, arguments analogous to those presented for Claim 13 are applicable to Claim 31.

With regards to Claims 32 and 33, arguments analogous to those presented for Claim 14 are applicable to Claims 32 and 33.

With regards to Claims 34 and 35, arguments analogous to those presented for Claims 15-17 are applicable to Claims 34 and 35.

With regards to Claim 36, arguments analogous to those presented for Claim 18 are applicable to Claim 36.

With regards to Claim 37, arguments analogous to those presented for Claim 19 are applicable to Claim 37.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda (U.S. 6,459,511) in view of Kaplan (U.S. 5,963,916).

Regarding Claim 2, Haneda does not explicitly disclose the method of Claim 1 wherein the purchasing step (a) can occur prior to receiving the plurality of images from the user.

Kaplan discloses a system for on-line user-interface multimedia based preview wherein purchasing can occur prior to receiving a plurality of images from the user (Figure 34; Column 15, Lines 40-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Haneda's invention according to the teachings of Kaplan to perform purchasing step (a) prior to receiving the plurality of images from the user because it will expand versatility of ordering images from a desired album utilizing on-line ordering based on prior subscription.

Regarding Claim 3, Haneda does not explicitly disclose the method of Claim 1 wherein the purchasing step (a) can occur prior to the plurality of images being captured.

Kaplan discloses a system for on-line user-interface multimedia based preview wherein purchasing can occur prior to the plurality of images being captured (Figure 34; Column 15, Lines 40-67).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Haneda's invention according to the teachings of Kaplan to perform purchasing step (a) prior to the plurality of images being captured because it will expand versatility of ordering images from a desired album utilizing on-line ordering based on prior subscription.

With regards to Claim 21, arguments analogous to those presented for Claim 2 are applicable to Claim 21.

With regards to Claim 22, arguments analogous to those presented for Claim 3 are applicable to Claim 22.

7. Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda (U.S. 6,459,511) in view of Morag (U.S. 6,324,545).

Regarding Claim 4, Haneda does not explicitly disclose the method of claim 1 wherein the receiving step (a) further includes the step of:

(c1) receiving from the user the information, if any, and the plurality of images directly from the digital imaging device.

Morag discloses a method of generating an album wherein a plurality of images directly from the digital imaging device (Figure 1; Column 5, Lines 46-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Haneda's invention according to the teachings of Morag to receive from the user the information, if any, and the plurality of images directly from the digital imaging device because it will expedite image processing for generating a personalized album.

With regards to Claim 23, arguments analogous to those presented for Claim 4 are applicable to Claim 23.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehrdad Dastouri whose telephone number is (703) 305-2438. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**MEHRDAD DASTOURI  
PRIMARY EXAMINER**



Mehrdad Dastouri  
Primary Examiner  
Group Art Unit 2623  
June 30, 2004